

REMARKS

Office Action

Claim Rejection

35 U.S.C. § 112, First Paragraph – Written Description

Claims 1-3 stand rejected under 35 U.S.C. §112, first paragraph, for allegedly failing to comply with the written description requirement. While the Examiner acknowledges that the specification is enabling for the particular HCV NS3 helicase proteins with dU₈, dU₁₀, and dU₁₂ oligonucleotides, the Examiner states that no basis has been pointed to for dU₆, dU₇, dU₉, and dU₁₁ nucleotides. Applicants traverse.

The specification teaches a preference for an oligonucleotide that is between about 6 and 12 bases. *See*, page 14, first full paragraph. Further, the specification exemplifies three species within that group of dU oligonucleotides between 6 and 12 bases. Specifically, the specification teaches that dU₈, dU₁₀ and dU₁₂ show essentially the same electron density for the DNA. *See*, page 66, first paragraph. In fact, the specification also teaches a preference for a dU₈ oligonucleotide. *See*, page 14, first full paragraph. A teaching of three species within a group of seven, where all three species show essentially the same characteristics in question, is sufficient written description for a claim to the group.

The PTO Written Description Guidelines state that “the written description requirement for a claimed genus may be satisfied through sufficient

description of a representative number of species by . . . disclosure of relevant, identifying characteristics”. *Guidelines for Examination of Patent Applications Under the 35 U.S.C. 112, ¶1, “Written Description” Requirement*, 66 Fed. Reg. 1099, (Jan. 5, 2001), 1106 (“Guidelines”). As discussed above, applicants have done just that, by describing the common attributes or features of the elements possessed by a representative number of the members of the genus. The *Guidelines* confirm that “[d]escription of a representative number of species does not require the description to be of such specificity that it would provide individual support for each species that the genus embraces.” *Id.*

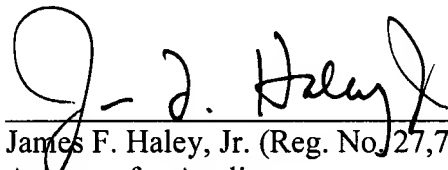
Rather, as the *Guidelines* indicate, a person of skill in the art would not expect substantial variations among the claimed species, thus, a representative number of species is disclosed, and the level of skill or knowledge in the art is adequate to determine the applicant was in possession of the claimed invention. The specification clearly contains a written description of single-stranded dU oligonucleotides consisting of between 6 and 12 nucleotides. Accordingly, the written description rejection should be withdrawn.

Application No.: 09/303,216
Office Action dated April 16, 2007
Response to Office Action dated October 16, 2007

Conclusion

Applicants request that the Examiner allow the pending claims to issue.
If the Examiner believes that a telephonic interview would be helpful, she is invited to call the undersigned at any time.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "J. F. Haley, Jr.", is written over a horizontal line.

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